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21706	7590	05/09/2006	EXAMINER	
NOTARO AND MICHALOS			MEINECKE DIAZ, SUSANNA M	
100 DUTCH HILL ROAD				
SUITE 110			ART UNIT	PAPER NUMBER
ORANGEBURG, NY 10962-2100			3623	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/782,864	ROOSEVELT ET AL.
Examiner	Art Unit	
Susanna M. Diaz	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 February 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 31-50 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 31-50 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All   b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date .  
4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

1. This final Office action is responsive to Applicant's amendment filed February 17, 2006.

Claims 1-30 have been cancelled.

Claims 31-50 have been added and are presented for examination.

### ***Response to Arguments***

2. Applicant's arguments filed February 17, 2006 have been fully considered but they are not persuasive.

Regarding the rejection under 35 U.S.C. § 101, Applicant traverses the technological arts requirement in light of *In re Lundgren* (pages 9-10 of Applicant's response). Consequently, the technological arts requirement has been withdrawn.

Applicant argues that the newly added claims produce a useful, concrete, and tangible result (page 10 of Applicant's response); however, the Examiner respectfully disagrees for the reasons presented in the § 101 rejection found below.

Applicant argues that the written description requirement under 35 U.S.C. § 112, 1<sup>st</sup> paragraph is not relevant to the Examiner's assertion that the claimed invention is performed by humans and therefore will not yield consistent results from use to use (pages 11-12 of Applicant's response). The Examiner submits that the 35 U.S.C. § 112, 1<sup>st</sup> paragraph rejection for lack of adequate written description is based on the fact that Applicant's specification does not reasonably convey the intended scope of the various claim limitations, especially those specifically identified in the rejections under 35 U.S.C.

§§ 101 and 112, set forth below. While Applicant's specification provides support for the overview of the claimed concepts, these concepts are very abstract and therefore require further clarification what Applicant's intended claim coverage is. Neither the claims nor the specification clarify Applicant's intended claim coverage, thereby supporting Examiner's assertion that the Applicant's specification fails to adequately explain how the invention functions and what the invention truly entails.

Applicant further argues that the rejections under 35 U.S.C. § 112 should be withdrawn for the same reasons Applicant asserted that the rejection under 35 U.S.C. § 101 should be withdrawn (page 14 of Applicant's response). However, the § 101 rejections are not being withdrawn at this time, thereby rendering moot the assertion that the § 112 rejections should be withdrawn for the same reasons.

Applicant argues that "it is well-settled that process claims are not directed to non-statutory subject matter 'merely because some or all of the steps therein can be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think.' *In re Musgrave*, 167 U.S.P.Q. 2880 (C.C.P.A. 1970)." (Page 15 of Applicant's response) The Examiner submits that the claimed invention was not simply rejected as being non-statutory for comprising mental steps *per se*, but instead because the claimed invention fails to produce a useful, concrete, and tangible result (using the rationale set forth in the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility"). The fact that all recited steps are conducted by a human user without any translation into substantially repeatable results was largely emphasized for the role this fact has played

and continues to play in the lack of concreteness and tangibility exhibited by the claimed invention.

In summary, Applicant's arguments are non-persuasive. The rejections have been revised to address Applicant's new claims.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 31-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 31-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

All of the steps recited in claims 31-50 are performed entirely by a human. Furthermore, all of these steps are completely subjective since the scope of each limitation is defined by the particular human carrying out each step. There is no

transformation of the results of these steps into any concrete and tangible result, e.g., via a quantifiable method that repeatedly translates into real-world, meaningful, and consistent results. One skilled in the relevant art would not be able to repeatedly generate consistent and reproducible results when practicing the invention because all steps vary widely based on the human performing each step. Therefore, one skilled in the relevant art would not be able to make and/or use the invention, as intended by Applicant in light of Applicant's disclosure.

How are all of verbal, emotional, visual, musical, spatial, worldly, physical, mathematical, and pragmatic intelligence defined and judged? Applicant's specification provides no quantifiable or otherwise concrete methodology for establishing all of these types of intelligence in a consistent fashion. In other words, since Applicant's invention is totally reliant on the subjective interpretation of a human, which will likely vary from human to human, how is intelligence consistently evaluated so that one user might judge a person as being musically intelligent while another user might judge the same person as musically inept? Consequently, the metes and bounds of Applicant's desired claim coverage are unclear, thereby rendering the claims vague and indefinite. Applicant's disclosure fails to provide any insight into these issues, thereby failing to shed any light of the intended operation of the invention in reference to this limitation.

The claimed invention also recites details of conducting "idea exercises" (e.g., see claims 40-43). Merely thinking could be interpreted as an idea exercise. Again, the concept of conducting idea exercises is so vague and indefinite that the scope of claims 40-43 further renders the metes and bounds of the claimed invention ambiguous.

Again, Applicant's disclosure fails to provide any insight into these issues, thereby failing to shed any light of the intended operation of the invention in reference to this limitation.

While all of claims 31-50 recite the provision of stimuli, claims 49-50 specify that "the stimuli promote thought of ideas about the product or service." Again, the ability of stimuli to "promote thought of ideas about the product or service" is purely subjective. While a given stimulus might "promote thought of ideas about the product or service" with one person, it might not have any effect at all on another person, thereby failing to clearly set forth the intended scope of the claims. Applicant's disclosure fails to provide any insight into these issues, thereby failing to shed any light of the intended operation of the invention in reference to this limitation.

Claims 31-44 and 48-50 recite that design parameters are developed. What is the scope of developing a design parameter? Is development performed in each individual team member's mind? Is it openly discussed and agreed upon? Is it developed, or advanced (as an improvement), in relation to the original idea related to each design parameter? Applicant's disclosure fails to provide any insight into these issues, thereby failing to shed any light of the intended operation of the invention in reference to this limitation.

The aforementioned problems arise throughout all of the claims. The intended metes and bounds of the claimed invention are ambiguous since they are not reproducible since every human user would practice the invention differently in light of the purely subjective nature of the invention. The specification does not adequately

disclose the level of details required by one skilled in the relevant art to be enabled to make and/or use the invention with consistency and confidence that the results are reproducible, tangible, concrete, and meaningful in a real-world context.

Appropriate correction and/or clarification is required.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 31-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the steps recited in claims 31-50 are performed entirely by a human. Furthermore, all of these steps are completely subjective since the scope of each limitation is defined by the particular human carrying out each step. Consequently, the intended metes and bounds of each recited limitation are unclear for the reasons set forth in greater detail below.

How are all of verbal, emotional, visual, musical, spatial, worldly, physical, mathematical, and pragmatic intelligence defined and judged? Applicant's specification provides no quantifiable or otherwise concrete methodology for establishing all of these types of intelligence in a consistent fashion. In other words, since Applicant's invention is totally reliant on the subjective interpretation of a human, which will likely vary from human to human, how is intelligence consistently evaluated so that one user might judge a person as being musically intelligent while another user might judge the same

person as musically inept? Consequently, the metes and bounds of Applicant's desired claim coverage are unclear, thereby rendering the claims vague and indefinite.

The claimed invention also recites details of conducting "idea exercises" (e.g., see claims 40-43). Merely thinking could be interpreted as an idea exercise. Again, the concept of conducting idea exercises is so vague and indefinite that the scope of claims 40-43 further renders the metes and bounds of the claimed invention ambiguous.

While all of claims 31-50 recite the provision of stimuli, claims 49-50 specify that "the stimuli promote thought of ideas about the product or service." Again, the ability of stimuli to "promote thought of ideas about the product or service" is purely subjective. While a given stimulus might "promote thought of ideas about the product or service" with one person, it might not have any effect at all on another person, thereby failing to clearly set forth the intended scope of the claims.

Claims 31-44 and 48-50 recite that design parameters are developed. What is the scope of developing a design parameter? Is development performed in each individual team member's mind? Is it openly discussed and agreed upon? Is it developed, or advanced (as an improvement), in relation to the original idea related to each design parameter?

Appropriate correction is required.

*Because claims 31-50 are so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims. See *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962); Ex parte*

*Brummer, 12 USPQ 2d, 1653, 1655 (BdPatApp&Int 1989); and also In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). Prior art pertinent to the disclosed invention has nevertheless been cited and applicants are reminded they must consider all cited art under Rule 111(c) when amending the claims to conform with 35 U.S.C. 112.*

### ***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 31-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)).

In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77). Additionally, a claim may not preempt abstract ideas, laws of nature or natural phenomena nor may a claim preempt every “substantial practical application” of an abstract idea, law of nature or natural phenomena because it would in practical effect be a patent on the judicial exceptions themselves (*Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972)). (Please refer to the

"Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" for further explanation of the statutory requirement of 35 U.S.C. § 101.)

All of the steps recited in claims 31-50 are performed entirely by a human. Furthermore, all of these steps are completely subjective since the scope of each limitation is defined by the particular human carrying out each step. There is no transformation of the results of these steps into any concrete and tangible result, e.g., via a quantifiable method that repeatedly translates into real-world, meaningful, and consistent results. One skilled in the relevant art would not be able to repeatedly generate consistent and reproducible results when practicing the invention because all steps vary widely based on the human performing each step; therefore, the claimed invention is not concrete. Furthermore, the claimed invention does not expressly generate an effect in the real-world. In other words, the generated ideas are not necessarily implemented to effect any tangible change. As a matter of fact, one idea could result in maintaining status quo (i.e., not doing anything), which does not effect any real-world, or tangible, change.

How are all of verbal, emotional, visual, musical, spatial, worldly, physical, mathematical, and pragmatic intelligence defined and judged? Applicant's specification provides no quantifiable or otherwise concrete methodology for establishing all of these types of intelligence in a consistent fashion. In other words, since Applicant's invention is totally reliant on the subjective interpretation of a human, which will likely vary from human to human, how is intelligence consistently evaluated so that one user might

judge a person as being musically intelligent while another user might judge the same person as musically inept? Consequently, the claimed invention lacks a concrete result.

The claimed invention also recites details of conducting “idea exercises” (e.g., see claims 40-43). Merely thinking could be interpreted as an idea exercise, which is a very abstract concept that lacks concreteness and tangibility and possibly usefulness (depending on what one is thinking and/or what the thought process is ultimately used for).

While all of claims 31-50 recite the provision of stimuli, claims 49-50 specify that “the stimuli promote thought of ideas about the product or service.” Again, the ability of stimuli to “promote thought of ideas about the product or service” is purely subjective. While a given stimulus might “promote thought of ideas about the product or service” with one person, it might not have any effect at all on another person. Again, the claimed invention does not produce any substantially repeatable, or concrete, result.

Claims 31-44 and 48-50 recite that design parameters are developed. What is the scope of developing a design parameter? Is development performed in each individual team member’s mind? Is it openly discussed and agreed upon? Is it developed, or advanced (as an improvement), in relation to the original idea related to each design parameter? The concept of developing design parameters is also abstract and fails to add a useful, concrete, and tangible result to the claimed invention.

In other words, the claimed invention is effectively a brainstorming session *per se*, which is not patentable because it is not statutory subject matter. The metes and bounds of the claimed invention vary widely depending on who is practicing the

invention. If the results of an idea generation session were somehow transformed into some quantifiable results that could consistently be analyzed to yield substantially reproducible results, then the interpretation of human subjectivity would not necessarily preclude the claimed subject matter from being statutory. One of the main problems with the instantly claimed invention is that Applicant has not effectively conveyed the scope of desired claim coverage.

In summary, claims 31-50 fail to produce a useful, concrete, and tangible result and are therefore deemed to be non-statutory.

Appropriate correction is required.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

May 1, 2006